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Daniel Lecomte

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WASHINGTON, DC 20006

EXAMINER

KIM, STEVEN S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,921	Applicant(s) LECOMTE, DANIEL	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30,32 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-30,32 and 36-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on December 15, 2009 (hereinafter "Amend1209").

Status of Claims

2. Claims 21-30, 32, and 36-46 are pending.
3. Claims 21, 28, 30, 36, 37, and 40 have been amended.
4. Claims 1-20, 31, 34, and 35 have been previously canceled.
5. Claim 33 is canceled.
6. Claims 45 and 46 have been newly added.

Response to Arguments

7. Claim Objections

Claim objections on claims 21-23, 24-30, 32, 43, and 44, objections in previous office action dated 9/24/2009 (hereinafter "oa0909"), are withdrawn in view of Applicant's amendments.

8. Specification

Examiner withdraws the specification objection in oa0909 in view of Applicant's remark in Amend1209. The amendment, however, requires an objection on the specification (see below).

9. 35 USC 101 Rejections

Examiner withdraws the specification objection in oa0909 in view of the amendments in Amend1209.

10. 35 USC 112 Rejections

Applicant has sufficiently addressed the 112 rejections on claims with exception to claim 37, specifically "mean for" that invoke 112, 6th paragraph. The written description does not contain "mean for permitting a user to access a burned DVD containing stream corresponding to a video sequence selected by the user from the video server". Hence, the written description fails to clearly link the disclosed structure, material, or acts to the claimed function.

The newly amended language requires further 112 rejections under 2nd paragraph on claims 21-30, 32, and 43-45 (see below).

11. 35 USC 103 Rejections

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Specification

12. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- “producing a main stream in a nominal format of the original video sequence, using *video processing equipment*” (see claim 21),

- “producing complementary digital information based on said second part, *using the video processing equipment*” (see claim 21), and
- “*mean for permitting a user to access a burned DVD containing stream corresponding to a video sequence selected by the user from the video server*” in claim 37.

Claim Rejections - 35 USC § 112, 2nd paragraph

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 21-30, 32, and 43-45 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

15. Independent claim 21 has been amended to recite ““producing a main stream in a nominal format of the original video sequence, using *video processing equipment*” and “producing complementary digital information based on said second part, *using the video processing equipment*”. Given that the original description does not describe “video processing equipment”, it is unclear what the video processing equipment represents. For example, the Fig 1. of the instant application depicts multiple devices within a device(s). Moreover, the claim has been amended to include newly added step that recites “receiving a selection by a user”. It is unclear whether the recite step “receiving” is performed “by the user” or “a selection” performed “by a user”. Examiner will interpret as “a selection” performed “by a user”. Examiner also recommends amending the recited “distributing the main stream to the user in response to a selection

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by the user" to "distributing the main stream to the user in response to the received selection" to clarify the selection(s). An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989). Claims 22-30, 32, and 43-45 are rejected similarly as each depends on claim 21

16. As per claim 37, the claim recites "means for permitting a user to access a burned DVD containing stream corresponding to a video sequence selected by the user from the video server". The claim element "means for" is to be interpreted as a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The written description fails to clearly link the disclosed structure, material, or acts to the claimed function.

17. Applicant is required to:

- amend the claims so that the claim limitations will no longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- state on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed

function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

18. Claim 26 recites "wherein the selection". The independent claim, however, recite multiple "a selection". It is unclear which selection the claim is referring to.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 21-30, 32-33, and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,892,900 (hereinafter "Ginter") and US Patent Application No. 2002/0413807 (hereinafter "Komatsu") in view of US Patent Application 2002/0100052 (hereinafter "Daniels").

21. In regards to claims 21, 36, 45 and 46, Ginter discloses distributing the main stream to a user in response to a selection by the user (see Ginter, see Fig. 1 and Fig. 3; Fig. 72B – 72D; col./lines 53/39 -56/65). Ginter further discloses a flexible distribution of electronic content, controlling of the electronic content (see col. 1, lines 9-30), and sending of complementary digital information to the user during viewing of the modified main stream sent to the user on the material support supplied by the distributor (see col.

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26, lines 10-43, use of clearinghouse to control the VDE activities; col. 309, lines 1-18, routing of information using two containers; col. 342, lines 21-35, use of two depositories). Ginter further discloses personalizing digital content (see Fig. 5B). Ginter also discloses a modification stage of packaging elements of content into a container (see col. 59, lines 7-67).

22. Ginter, however, does not specifically disclose: dividing content of a selected original video sequence into two parts, a larger part and a smaller part, using video processing equipment; producing a main stream in a nominal format of the selected original video sequence, wherein the main stream is produced based on said larger part; producing complementary digital information based on said smaller part, wherein the complementary digital information is personalized for respective users and is complementary to the main stream, storing the complementary digital information in a server, and sending the complementary digital information corresponding to the main stream to the user, in response to information received from the user's equipment upon initiation of viewing the main stream, during viewing of the main stream.

23. Komatsu, on the other hand, discloses method comprising:

- dividing content of a selected original video sequence into two parts, a larger part and a smaller part, using video processing equipment (see Fig. 1; ¶0019; ¶0033, content separator that divides a content into insufficient and complementary; ¶0044; ¶0045; ¶0064);

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- producing a main stream in a nominal format of the selected original video sequence, wherein the main stream is produced based on said larger part (see Fig. 1; ¶0019; ¶0033; ¶0044; ¶0045; ¶0047; ¶0049; ¶0064);
- producing complementary digital information based on said smaller part, wherein the complementary digital information is complementary to the main stream, wherein the complementary digital information is personalized for respective users and is complementary to the main stream (see Fig. 1; ¶0019; ¶0033; ¶0045; ¶0046; ¶0048; ¶0064);
- storing the complementary digital information in a server (see Fig. 2; ¶0045; ¶0071);
- sending the complementary digital information corresponding to the main stream to the user, in response to information received from the user's equipment upon initiation of viewing the main stream, during viewing of the main stream (see ¶0036; ¶0037; ¶0041; ¶0048; ¶0058; ¶0074-¶0079).

24. Ginter and Komatsu are analogous art since they are from the same field of endeavor of protecting/controlling content usage. It would have been obvious to one of ordinary skill in the art to combine the teachings. The motivation for doing so would have been to allow flexible and additional layer of protecting the digital content usage (see Komatsu, ¶0090).

25. Komatsu further discloses a video bank, analysis device, and at least one distribution equipment (see Fig. 1 - Fig. 4).

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26. While Komatsu discloses sending of the complementary content "at the time of reproduction" (see ¶0024 and ¶0041), Both Ginter and Komatsu are silent whether the sending of the complementary content is "during viewing as recited in the claims. Daniels, however, discloses sending of another portion of the requested video on demand during the playing of the VOD selection (see claim 8 and claim 19). It would have been obvious to one of ordinary skill in the art, at the time the invention was made to include in the method of processing distribution of digital content of Ginter and Komatsu including sending the complementary content during the viewing of the selection as taught by Daniels since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

27. As per claim 22 and 23, Ginter also discloses storing digital information that identifies a distributor, wherein the main stream contains digital information identifying the distributor (see col./line 37/15-38/35, watermarking; col. 304, lines 17-19).

28. As per claims 24 and 43, Ginter further discloses recording the main stream at the distribution site on a standard physical support medium, wherein the standard physical support medium is a DVD disk (see col. 3; lines 22-26, delivery means including optical/magnetic disk, col. 6-21; col. 62, lines 31-50). Komatsu also discloses recording the main stream on a standardized support medium (see ¶0070).

29. As per claim 25, the prior art discloses claim 43 elements as described above. Ginter further discloses reading the standard physical support medium with an apparatus comprising a user identifier (see col. 42, lines 35-40; col. 43, lines 10-14; col. 45, lines 57-62).

30. As per claim 30, the prior art discloses claim 43 elements as described above. Ginter further discloses forwarding the standard physical support medium to the user by a distributor (see col. 3, lines 21-25; Fig. 2 and Fig. 2A). Komatsu discloses during use of the standard physical support medium obtained from the distributor, sending the complementary digital information as viewing of the video stream progresses (see ¶0070; ¶0036; ¶0037; ¶0041; ¶0048; ¶0058; ¶0074-¶0079).

31. As per claim 26, the prior art teaches claim 21 as described above. Ginter further discloses wherein the selection is received from a personal terminal of the user communicating via a public telecommunication network a public telecommunication network (see Fig. 1 and Fig 3; col. 307, lines 5-10).

32. As per claims 27 and 44, the claims are directed to further step of storing the main stream at a distribution site wherein the storing is conditional upon transmission of identifying information by the user. The prior art teaches flexible distribution of

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electronic content and controlling the use of the content (see Ginter, col. 1, lines 9-30, Fig. 77, Fig. 78; Komatsu, ¶0090). The prior art also teaches identifying user information, e.g. payment (see Ginter, Fig. 77 and Komatsu, ¶0075). Hence, a predictable result is to store the content in the distribution site, for distribution, conditional upon authenticating the user for payment.

33. As per claims 28 and 29, Ginter discloses performing processing specific to the distributor designated by the user in the user's selection (see Fig. 5B; Fig. 26A; Fig. 78). Furthermore, Komatsu discloses performing processing specific to the distributor wherein the server is connected to a database (see Fig. 3) in which the processing specific to the distributor is associated with an identifier of the distributor to which a resulting main stream is transmitted (see ¶0077 - ¶0078). Ginter also discloses wherein the server is connected to a database in which the processing is associated with an identifier of the distributor to which a resulting main stream is transmitted (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54).

34. As per claim 32, Ginter discloses wherein at least one of said producing the main stream or said producing complementary digital information comprises performing processing specific for a respective user who selects the original video sequence (see Fig. 5B; Fig. 26A; Fig. 78). Furthermore, Komatsu discloses wherein at least one of said producing the main stream or said producing complementary digital information comprises performing processing specific for a respective user (see ¶0034; ¶0036).

35. As per claim 33, Ginter discloses wherein the server is connected to a database in which the processing specific for the respective user is associated with the respective user (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54). Furthermore, Komatsu discloses wherein the server is connected to a database in which the processing specific for the respective user is associated with the respective user (see ¶0034; ¶0036; Fig. 2).

36. As per claim 30 and 43, Ginter discloses use of physical support, i.e. disk, in distributing content (see col. 3, lines 21-25). Komatsu discloses sending of complementary digital information as viewing of the video stream progresses (see claim 8 and claim 19).

37. As per claim 32, Ginter discloses wherein the stage of modifying the original video sequence corresponds to a processing specific for each user identified during the selection stage (see limitations in claim 21, user selecting necessarily anticipates this limitation).

38. As per claim 33 Ginter discloses wherein the server is connected to a database in which each specific processing is associated with a user (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54).

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39. As per claims 37 and 39, Ginter further discloses a DVD burner, a means of accessing a burned DVD, and a printer (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10) .

40. As per claim 38, Ginter further discloses wherein the at least one piece of distribution equipment and the server are integrated in a single system (see col. 281, lines 23-30). Furthermore, the claim is representative of making integral. See *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961).

41. As per claim 40, Ginter also discloses a device for distribution of recording supports (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10).

42. As per claim 41, Ginter discloses wherein the at least one piece of distribution equipment is coupled to receive from the server at least a main stream and is configured to store the main stream (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10).

43. As per claim 42, Ginter further discloses a recording device to record the main stream onto a standard physical support medium (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10).

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44. Additionally, claims 36-42 and 46 are directed to a system specifically to a video server and distribution equipment. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 7,382,969 discloses dividing video content into two, transmitting the split contents in a separate channel, and combining the two during viewing; US Patent Application No. 2002/0108035 discloses splitting file into two and combining at destination device; US Patent Application No. 2003/0135464 discloses distribution of electronic content; US Patent 6,308,887 discloses super-kiosk.

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

47. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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